



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/656,002 | 09/05/2003 | Steven A. Reese | 044182 / 305880 | 7517 |

7590 08/09/2006

Pillsbury Winthrop LLP
Intellectual Property Group
Suite 200
11682 El Camino Real.
San Diego, CA 92130-2092

| |
|----------|
| EXAMINER |
|----------|

BOECKMANN, JASON J

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3752

DATE MAILED: 08/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/656,002 | Applicant(s) REESE ET AL. | |
| | Examiner Jason J. Boeckmann | Art Unit 3752 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-20 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 May 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

The drawings were received on 5/15/2006. These drawings are not acceptable due to the following reasons.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "112" appears to represent three different parts in figures 4A- 4B. In figure 4A, reference number appears to be pointing to some sort of elongated clamp or stopper. In figure 4B, reference number 112 appears to be referencing a group of cylinders used to keep the viewing sample in place. Lastly, in figure 4C, reference number 112 appears to be referring to two rods. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-7, 9, 12-15, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wagener et al (4,262,991).

Wagener et al shows a precision travel staging system comprising a precision stage (base plate, not shown), a fixed portion (9 (plate 9 does not have to be moved)) configured to be attached to the precision stage, a movable portion (1) operatively coupled to the fixed portion (9) and selectively movable relative thereto, a securing mechanism (object holder, not shown, column 2, line 6) configured to secure a substrate at a predetermined location relative to the moving portion (1) and an actuator mechanism (5,8) operative to provide movement of the movable portion (1) in one direction relative to the fixed portion.

Regarding claims 4 and 12, the fixed portion (9) and the movable portion (1) both comprise an aperture cooperating to form a window (figure 1, not labeled) in the substrate holder and the securing mechanism is operative to secure the substrate at a selected location relative to the window.

With respect to claims 5-7 and 13-15, the staging system further includes an indexed reference system (shown on the movable portion 1, not labeled). The

Art Unit: 3752

reference system comprises a pointer (shown on the movable portion 1, not labeled) and a plurality of reference indicia (shown on the movable portion 1, not labeled).

With respect to the method claims 17, 19 and 20, the apparatus shown by Den Engelse et al is capable of performing the method or steps in the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 8, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagener et al (4,262,991) in view of Den Engelse et al (5,900,708).

Wagener et al shows all aspects of the applicant's invention as in claims 1 and 9, but does not include a motor or a spring biased securing mechanism. However, Den Engelse et al shows a substrate holder comprising a spring biased securing mechanism (50) used to secure the substrate to the stage and an actuator mechanism comprising a

Art Unit: 3752

motor (34, 36). It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to substitute the securing mechanism (50) of Den Engelse et al for the securing mechanism (not shown) of Wagener et al in order to better secure the substrate to the movable stage 1. Additionally, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the actuator mechanism comprising a motor (34, 36) of Den Engelse et al in order to make the movable portion (1) move automatically.

Regarding the method claim 18, the apparatus of Den Engelse et al as modified by Wagener et al is capable of performing the method or steps in the claim.

Allowable Subject Matter

Claims 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments filed on 5/15/2006 have been fully considered but they are not persuasive. Examiner believes that Wagner does anticipate the claimed invention. Wagner does disclose a moveable stage plate (9) with respect to the fixed part and a moveable object holder/plate (1) with respect to the stage plate, but that does not mean that the both the moveable stage plate and the moveable object holder have to move to

Art Unit: 3752

use the device. The moveable stage plate 9 is considered fixed if the user does not move it with respect to the base plate.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason J. Boeckmann whose telephone number is (571) 272-2708. The examiner can normally be reached on 7:30 - 5:00 m-f, first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Scherbel can be reached on (571) 272-4919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3752

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JJB JJB 7/28/06

DINH Q. NGUYEN
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Dinh Q. Nguyen', written over the printed name and title.